

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

REMARKS

Claims 1 and 3-22 are now present in this application. By this Amendment, claim 2 has been canceled and claims 1, 4 and 17 have been amended. No new matter is involved.

Reconsideration of this Application, as amended, is respectfully requested.

Claims 1-11, 13 and 22 stand rejected under 35 U.S.C. 102(b) as being unpatentable over Thornton, et al., U.S. Patent 6,048,300. This rejection is respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

This rejection is fundamentally flawed, because the rejection misstates what Thornton's element 54 is. The rejection indicates that element 54 in Thornton is a switch lever. However, Thornton clearly discloses that element 54 is a drive unit (col. 9, lines 6019) and, in particular, a dummy drive unit (col. 9, lines 58-60).

Moreover, while Thornton does disclose a switch lever 166 (in col. 10, lines 4-31 and Fig. 7, for example), switch lever is not disclosed as having two positions. Switch lever 166 has a lever arm 168, which is disclosed as engaging washer tangs 162, and it is the washer tangs 162 that move with respect to lever arm 168. Lever arm 168 is not disclosed as moving. In this regard, Thornton discloses, in col. 10, lines 17-31, that tangs 162, which are rotatably mounted on the bearing sleeve of shaft 122, engage one another serially from tang 162b to tang 162a, and that tang 162a engages lever arm 168 of switch lever 166 to rotate against the spring force until one of a pair of microswitches 174 is operated. It is clear that what rotates are the washer tangs, not the lever arm 168. Only the washer tangs change position, while the lever arm 168 remains stationary.

Thornton '300 fails to disclose a lever element, which is pivotally mounted near said guidance channel, and which lever element is in a first position, when said distal end of said source wire is not present in its reference position and whereas said lever element is in a second position, when said distal end is present in its reference position.

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

With the features of present claim 1, a mechanical construction of a lever element is suggested, which gives a more accurate and reliable indication about the passage of the energy emitting source passed its reference position within the guidance channel of the afterloading apparatus, as with the prior art devices. Unlike the prior art, the lever element according to the invention is not susceptible for any disturbances, like debris from the guidance channel, which debris may accumulate within the guidance channel due to the advancement and the retraction of the source wire within the afterloading apparatus. The reliability and accuracy of the sensing device is thus ensured as the displacement of the lever element due to the displacing distal end of the source wire activates the detection means being mounted in a separate cavity or place within the afterloading cartridge, which cavity is isolated from the guidance channel.

Accordingly, Thornton clearly does not disclose a lever element with two positions, as claimed.

Furthermore, the assertion that the home sensor (114) may include a lever element similar to that of 54 does not make out a *prima facie* case that such a construction is explicitly disclosed, or inherently disclosed by Thornton, especially when, as explained by case law cited above, for something to be inherently disclosed, it cannot be just possibly disclosed, and cannot be just probably disclosed. Rather, it must necessarily disclosed, and the rejection is only relying on the *possibility* that it *may* occur.

Furthermore, claim 1 has been amended to recite a combination of features, including a sensing device comprising a lever element pivotally mounted near said guidance channel, which lever element is urged by said distal end in a first position, when said distal end of said source wire is not present in its reference position and whereas said lever element is in a second position, when said distal end is present in its reference position, and wherein said lever element is urged by said distal end in a third position when said distal end is past said reference position and wherein detecting means are present for detecting the presence of said lever element in said first, second or third position.

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

Thornton does not disclose the claimed combination of features. The relied upon portions of Thornton, including Figs. 7 and 8 of Thornton, and its accompanying description starting from col. 8, line 48, describe a mechanism to limit the maximum length of a dummy wire which is unwound from the drum and advanced through a catheter, which catheter is connected to the after loading device and is inserted at a certain treatment location within the patient's body. Hence, the mechanism serves to avoid advancement of the dummy wire too far within the patient's body. The mechanism is only activated once the dummy wire has reached its maximum length. During unwinding, the mechanism is not capable of detecting the actual position of the end of the dummy wire, as it does not incorporate an instantaneous length measurement *during unwinding and, hence, during displacement of the dummy wire (and its distal end) through the catheter.*

The mechanism of Figs. 7 and 8 only triggers the moment that the dummy wire has been unwound to its maximum length. At that moment, the (distal end of the) dummy wire is present at its final position *within the patient's body.* However, the mechanism does not provide detailed information about the actual position of the (distal end of the) dummy wire *during the unwinding before it has reached its final, maximum location.*

Thus, the Thornton embodiment of Figs. 7 and 8 cannot possibly sense the presence or actual location of a distal end of a source wire (with an energy emitting source), for example, whether the energy emitting source is inside the radiation-shielded compartment of the after loading device or already outside the device.

The claimed invention provides a more accurate and safer solution for determining where the distal end/energy emitting source is present. It incorporates a lever element which is urged by the distal end.

According to the claimed invention, the detection mechanism, e.g., a lever element, can distinguish between several positions or locations of the distal end of the wire. This is not the case with Thornton, where only the most extended (unwound) position of the dummy wire is detected.

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

Thornton fails to disclose a lever element according to the claimed invention, i.e., which is pivotally mounted near the guidance channel, and which is urged by the distal end of the wire (or energy emitting source) in a first, second and third position. Thornton also fails to disclose detection means which can distinguish between the several positions wherein the lever element can be urged by the distal wire end.

The features of the claimed invention provide a lever element which gives a more accurate and reliable indication about the passage of the energy emitting source past its reference position within the guidance channel of the after loading apparatus than does the applied art.

Accordingly, this rejection is fundamentally improper and does not make out a *prima facie* case of anticipation of the subject matter of claims 1-11, 13 and 22, and should be withdrawn.

Claims 12, 14 and 16-21 stand rejected under 35 U.S.C. 103 as being unpatentable over Thornton '300 in view of U.S. Patent 5,597,829 to Thornton. Claim 15 stands rejected under 35 U.S.C. 103 as being unpatentable over Thornton '300 in view of Loffler, U.S. Patent 5,997,462. These rejections are respectfully traversed.

The secondary reference to Thornton '829 does not overcome the deficiencies of the Thornton '300 reference. This Thornton '829 patent is merely relied upon to show a specific source wire with an energy emitting source provided with a magnetic tracking means in the form of a ferromagnetic ball.

The other secondary reference to Loffler also does not overcome the deficiencies of Thornton '300.

Nowhere in the prior art utilized by the Examiner, is the device for sensing the presence of the distal end of a source wire as is claimed in the present application, either suggested or rendered obvious. Accordingly, reconsideration and withdrawal of the 35 U.S.C. 102(b) and 103 rejections are therefore requested.

RECEIVED
CENTRAL FAX CENTER
JUN 30 2008

Application No. 10/769,790
Amendment dated June 30, 2008
Reply to December 31, 2007 Office Action

Docket No.: 3560-0136P

Accordingly, reconsideration and withdrawal of these rejections of claims 12 and 14-21 are respectfully requested.

Conclusion

In view of the above remarks, it is believed that claims 1-22 are allowable. Favorable reconsideration and an early Notice of Allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a three-month(s) extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$1,050.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: June 30, 2008

Respectfully submitted,

By 

Paul C. Lewis

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant